

Application Serial No. 10/822,330
Amendment dated September 20, 2005
Reply to Office Action dated August 30, 2005

REMARKS:**Status Of Claims**

Claims 14-20 were previously and are currently pending in the application with claim 14 being independent.

Office Action

In the Office Action, the Examiner imposed an election of species requirement. Specifically, the Examiner requires election between Figure 1, Figure 2, Figure 3, and Figure 4. Applicant hereby elects, with traverse, Figure 2. Furthermore, Applicant asserts that the currently pending claims are generic.

Applicant traverses this requirement, as the Examiner has not shown how the species are distinct. "The burden is on the examiner to provide reasonable examples that recite material differences." MPEP § 806.05(e). See also MPEP § 806.5(h). Specifically, "[e]very requirement to restrict has two aspects: (A) the reasons (as distinguished from the mere statement of conclusion) why the inventions *as claimed* are either independent or distinct; and (B) the reasons for insisting upon restriction therebetween". MPEP § 808. More specifically, as stated in MPEP § 808.02:

Where, as disclosed in the application, the several inventions claimed are related, and such related inventions are not patentably distinct as claimed, restriction under 35 U.S.C. 121 is never proper (MPEP § 806.05). If applicant optionally restricts, double patenting may be held.

Where the related inventions as claimed are shown to be distinct under the criteria of MPEP § 806.05(c) - § 806.05(i), the examiner, in order to establish

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reasons for insisting upon restriction, must show by appropriate explanation one of the following:

(A) Separate classification thereof: This shows that each distinct subject has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Patents need not be cited to show separate classification.

(B) A separate status in the art when they are classifiable together: Even though they are classified together, each subject can be shown to have formed a separate subject for inventive effort when an explanation indicates a recognition of separate inventive effort by inventors. Separate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search.

(C) A different field of search: Where it is necessary to search for one of the distinct subjects in places where no pertinent art to the other subject exists, a different field of search is shown, even though the two are classified together. The indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search. Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions.

As discussed on page 6 of the present application, each of figures 1-4 show a "method to interface navigation operations", and are therefore related. In imposing this election of species requirement, the Examiner has apparently found that the species are patentably distinct, otherwise "restriction under 35 U.S.C. 121 is never proper", as stated above. However, while the Examiner finds the species to be distinct, the Examiner has failed to provide "appropriate explanation", as also discussed above.

"The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement

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of conclusion is inadequate. The reasons upon which the conclusion is based should be given". MPEP § 816. In contrast, in the preset case, the Examiner asserts that the "application contains claims directed to the following patentably distinct species of the claimed invention". Page 2 of the August 30, 2005 Office Action. The Examiner's assertion is therefore a "mere statement of conclusion [and is therefore] inadequate".

In summation, as discussed above, the MPEP places a burden of proof on the Examiner in imposing the instant requirement. As the Examiner has not met this burden, this requirement is improper, cannot be sustained, and is therefore traversed.

Any additional fee which is due in connection with this amendment should be applied against our Deposit Account No. 501-791.

Respectfully submitted,

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